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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,898	10/03/2005	Colin William Francis	U 015646-1	9656
140	7590	12/06/2006	EXAMINER SINGH, SUNIL	
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			ART UNIT 3673	
			PAPER NUMBER	

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/525,898	Applicant(s) FRANCIS, COLIN WILLIAM	
	Examiner Sunil Singh	Art Unit 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1,4-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 line 8+, "upon downward ... said soil surrounding said shaft rotates in unison with said shaft" is recited; however no where in the originally filed disclosure is such language found, thus constituting new matter. The soil may rotate with the shaft but not during the longitudinal movement of the compaction member relative to the shaft.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1,4-8, 10-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 line 15, "mamber" is incorrect.

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Claim 5 line 1, "said transverse portion" lacks clear antecedent basis; it appears as if it should relate back to the "transverse part" called for in claim 1.

Claim 11 is similarly rejected as claim 5 above.

Claims 1,4-8,10-16 are ambiguously constructed and indeterminate in scope because they purport to claim both an apparatus and method of using of practicing the apparatus in a single claim

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1,4-8,10-16 are rejected under 35 U.S.C. 101 because they improperly embrace both product or machine and process. The language of 35 U.S.C 101 sets forth statutory classes of invention in alternative only. Ex parte Lyell, 17 USPQ2d 1549.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1, 4,5, 10,11,14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace, III (US 6202368) in view of Classen (US 4279104).

Wallace, III discloses a pier to be driven into an earth surface to support, said pier including: an auger member (16) including a shaft (14) that is rotated in a first direction to drive the auger member into the ground surface; a soil compaction member (12,32) to compact soil around the shaft, said compaction member including a sleeve (12) surrounding the shaft and movable relative thereto longitudinally of the shaft (see col. 8 line 35+), and a transverse part (32) extending laterally from and contacts the sleeve to engage the soil surrounding the shaft so that upon downward movement of the compaction member relative to the shaft soil surrounding the shaft is compacted; and wherein said sleeve is operatively associated with said shaft so that rotation of said compaction member causes rotation of said shaft (see the square cross section (see col. 8 line 15) of the shaft being housed in square receptacle (see col. 3 line 50) of the sleeve) to thereby drive said auger member. The pier includes a drive assembly having a threaded rod (50) so that upon rotation of said rod (50) the compaction member (12,32) moves relative to the shaft (see col. 8 line 35+). Nut (48) mounted internally of shaft (14). Wallace, III discloses the invention substantially as claimed. However, Wallace, III lacks the transverse part being attached to the sleeve. Classen teaches to attach a transverse part (20) to a sleeve (12). It would have been considered obvious to one of ordinary skill in the art to modify Wallace, III by attaching his transverse part to the sleeve as taught by Classen since such an arrangement facilitate transporting the apparatus by reducing the number of separate parts one needs to carry.

9. Claims 6-8,12,13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace III in view of Classen as applied to claims 5,11 above, and further in view of Edwards et al.

Wallace, III (once modified) discloses the invention substantially as claimed. However, the (once modified) Wallace, III lack apertures in plate (32). Edwards et al. teach apertures (see Fig. 2) in a base plate. It would have been considered obvious to one of ordinary skill in the art to further modify the (once modified) Wallace, III to include apertures in the plate as taught by Edwards et al. in order to provide a means for installing the pier structure.

Response to Arguments

10. Applicant's arguments filed 9/26/06 have been fully considered but they are not persuasive. Applicant argues that Classen does not have an auger. The examiner agrees. It should be noted that the examiner is relying on Wallace, III for teaching an auger (16). Applicant argues that neither Classen nor Wallace teach the use of a drive assembly as defined in his claims 1 and 10. It should be noted that the claims are directed to an apparatus and applicant is relying on it's use to determine patentability; therefore if the structure is taught by Wallace in view of other references then the claims do not patentable distinguish over the prior art. Applicant fails to point out exactly what structure the prior art does not teach. In response to applicant's argument that the prior art fails to teach the use of a drive assembly as called for in claims 1 and 10, it should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant argues that his invention distinguishes over Wallace since the sleeve and shaft are configured so as to rotate in unison. This is not concurred with. Wallace teaches a square shaft (see col. 8 line 15) housed within a square receptacle sleeve (see col. 3 line 50), therefore, they are configured to rotate in unison.

Applicant argues that his invention distinguishes over Wallace since the drive assembly allows the sleeve to move longitudinally with respect to the shaft to compact the soil. This is not concurred with. Wallace teaches a drive assembly having a threaded rod (50) so that upon rotation of said rod (50) the compaction member (sleeve)(12,32) moves relative to the shaft (see col. 8 line 35+) to compact the soil.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (571) 272-7051. The examiner can normally be reached on Monday through Friday 10:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Engle Patricia can be reached on (571) 272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sunil Singh
Primary Examiner
Art Unit 3673



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11/30/06